



Our Docket No.: 0325.00239

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11-4-03
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Risto D. Bell et al.

RECEIVED

Application No.: 09/410,160

Examiner: Garcia Otero, E.

OCT 29 2003

Filed:

September 30, 1999 Art Group: 2123

Technology Center 2100

For:

METHOD AND APPARATUS FOR AUTOMATED ENUMERATION,
SIMULATION, IDENTIFICATION AND/OR IRRADIATION OF DEVICE
ATTRIBUTES

I hereby certify that this letter, the response or amendment attached hereto are being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 21, 2003.

By:

Mary Donna Berkley
[Handwritten signature of Mary Donna Berkley]

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit, in triplicate, the following Reply Brief pursuant to 37 C.F.R. §1.193 for consideration by the Board of Patent Appeals and Interferences. Please charge any additional fees or credit any overpayment to our Deposit Account Number 50-0541.

Docket Number: 0325.00239

Application No.: 09/410,160

ARGUMENTS IN RESPONSE TO EXAMINER'S ANSWER

Appellants thank the Examiner for withdrawing all of the 35 U.S.C. §112 rejections.

Appellants continue to traverse the Examiner's assertion that the Background of the Invention section for the application is admitted prior art.¹ No such admission was made.

The Examiner incorrectly asserts that the Background of the Invention section for the application is "related to fuses on integrated circuit memories" in the Examiner's motivation arguments to combine with Kablanian.² The Background of the Invention section for the application makes no reference to memories. Therefore, the asserted motivation to combine the Background of the Invention section of the application with Kablanian appears to be based on an erroneous assertion.

Appellants' teachings on page 1, lines 16-20 of the application do not explicitly mention simulation path data, schematic path data or physical layout data. Assuming, *arguendo*, that the phrase "simulation path" implies "simulation path data" and the phrase "schematic path" implies "schematic path data" (never explained by the Examiner during prosecution and for which the Appellants' representative does not necessarily agree), no "physical layout" type phrase or phrases are mentioned in the two sentences from which one of ordinary skill in the art could imply "physical layout data". Instead, the Examiner appears to be using the claim language as a template to pick and choose words from the two sentences to imply physical layout data where none is taught.

Appellants respectfully traverse the Examiner's speculation that simulation path data, schematic path data and/or physical layout data may be inherent in Kablanian. Inherency requires

¹ Examiner's Answer, page 6, line 18.

² Examiner's Answer, page 17, section 11.B.1.2, lines 11-14.

certainty of results, not mere possibility.³ However, the Examiner's own wording is phrased as a possibility, "it also appears that these types of data may be inherent".⁴ Therefore, simulation path data, schematic path data and physical layout data are not inherent in Kablanian for lack of certainty.

The Examiner is confusing simulating a design with simulating a repair. Contrary to the Examiner's suggestion, Appellants did not state on page 13, lines 4-6 of the Appeal Brief that verification occurs after simulation **of the design**.⁵ Appellants merely stated that simulation **of the repair** must take place before verification of that repair can occur. Therefore, the Examiner's arguments in section 11.B.1.4 of the Examiner's Answer are moot because the Examiner is arguing against a statement that was never made by the Appellants.

The Examiner is making conflicting statements regarding page 1, lines 14-15 of the application. In particular, the Examiner asserts that four distinct claim elements are described in page 1, lines 14-15 of the application.⁶ However, the Examiner cites the action of "manual association" in line 14 of the Background as both claim elements "fuse report"⁷ and "repair file".⁸ Furthermore, no explanation is provided how page 1, lines 14-15 of the application teach or suggest the claimed step of listing physical locations.⁹ No explanation is provided how page 1, lines 14-15

³ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

⁴ Examiner's Answer, page 20, lines 9-10.

⁵ Examiner's Answer, page 22, lines 10-11.

⁶ Examiner's Answer, page 25, lines 14-17.

⁷ Examiner's Answer, page 25, second to last line.

⁸ Examiner's Answer, page 26, line 17.

⁹ Examiner's Answer, page 26, lines 4-12.

of the application teach or suggest the claimed step of listing an output of a repair program.¹⁰ Therefore, the Examiner still has not shown how the four claim elements in question are taught by page 1, lines 14-15 of the application.

Assuming, *arguendo*, that the external software taught by Kablanian implies a circuit to execute the external software, the Examiner has not shown that the implied circuit can compile data for each fuse, wherein the data comprises simulation path data as presently claimed. Therefore, the Examiner still has not established that the prior art teaches or suggests every element of the apparatus claims in groups 2 and 10.

The Examiner contends that the rejections for the method claims of group 1 also apply to the apparatus claim of group 3.¹¹ The Examiner continues to miss the fact that the apparatus claim of group 3 includes structure not provided in the method claims of group 1. Therefore, the Examiner has still not established evidence for every element as claimed.

The Examiner continues to use the incorrect assertion that the Background of the Invention section for the application concerns memories in the Examiner's motivation arguments to combine with Tzori. As noted above, no memories are mentioned in the Background of the Invention section. Therefore, the Examiner's arguments for motivation to combine Tzori with the Background section and Kablanian to repair memories appear to be based on an erroneous assertion.

The Examiner has not shown evidence of motivation to combine with Sample. The Examiner's entire motivation argument appears to be based on the phrase "burn fuses" that appears only once in Sample (in the Background section of Sample). The fact that references can be

¹⁰ Examiner's Answer, page 26, lines 21-24.

¹¹ Examiner's Answer, page 24, section 11.3.

combined or modified is not sufficient to establish *prima facie* obviousness.¹² Two isolated words from Sample do not appear to provide clear and particular evidence of motivation to combine.

The Examiner continues to use the incorrect assertion that the Background of the Invention section for the application concerns memories in the Examiner's motivation arguments to combine with Higgins. As noted above, no memories are mentioned in the Background of the Invention section. Therefore, the Examiner's arguments for motivation to combine Higgins with the Background section and Kablanian to repair memories appear to be based on an erroneous assertion.

Appellants respectfully traverse the Examiners suggestion that location information must be supplied to a laser repair device is inherent in "other prior art".¹³ Inherency requires certainty of results, not mere possibility.¹⁴ However, the Examiner admits uncertainty ("probably inherent"¹⁵) and thus fails to establish inherency.

CONCLUSION

Several of the arguments presented in the Examiner's Answer and in the Office Actions are based on a number of erroneous assertions made by the Examiner. For example, memories are not mentioned in the Background of the Invention section of the application, yet repairing memories by burning fuses with a laser appears to form a large portion for the Examiner's motivation arguments.

¹² M.P.E.P., Eighth Edition, Revised February 2003, §1243.01.

¹³ Examiner's Answer, page 31, lines 3-5.

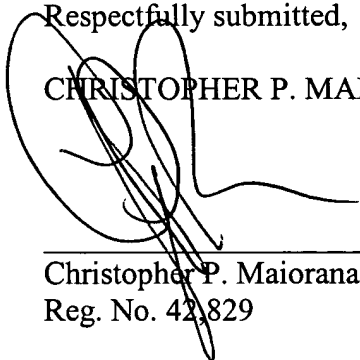
¹⁴ See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). See also, *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

¹⁵ Examiner's Answer, page 31, line 4.

The Examiner has also cited a handful of sentences in the Background of the Invention section of the application for several different rejections. In citing the same sentences repeatedly, the Examiner's arguments sometimes (i) conflict with each other, (ii) fail to show any similarity between the claim language and the cited language or (iii) appear to use the claims as templates. Therefore, Appellants request that any assertions may by the Examiner regarding statements made in the Background of the Invention section for the application, the U.S. Patent references and the Appeal Brief be viewed very carefully to ensure that the statements are actually part of the record.

Respectfully submitted,

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Dated: October 21, 2003

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